

## REMARKS

### **I. Front Page of Office Action**

The front page of the October 24, 2006 office action indicates that claims 1-47 are pending and rejected, and that the office action is final.

### **II. Status of Claims**

Claims 1-47 are pending.

Claims 1, 23, 45, and 46 are the only independent claims.

Claims 1-47 are pending and rejected.

### **III. Summary**

The inventions defined by the claims provide a central computer system communicating with plural retailer computer systems to offer to the retailers manufacturer product sampling programs, receive from the retailers acceptance, rejection, or counter offers to those programs, generate (at the central computer system, not at the retailer store computers) a list of each retail store's CIDs to receive product samples, and associated instructions for delivery of the product samples to the homes (or at the point of sale) of the consumers associated with the CIDs, preferably when the consumers's CIDs are identified at a POS. The cited art does not disclose these features. Deaton and O'Brien lack hierarchical features of the central server and several other claimed limitations. The Rochon WO publication is not prior art. The Rochon US patent application publication is not 103 prior art, and it does not anticipate what is claimed. Therefore, the rejections should be withdrawn and this application allowed.

### **IV. The Rejections of Claims 1-47 under 35 USC 103(a) Based Upon Deaton (USP 5,687,322, hereinafter "Deaton") in View of O'Brien (USP 5,832,457, hereinafter "O'Brien")**

The examiner rejects claims 1-47 based upon the teachings of Deaton and O'Brien. The examiner asserts that Deaton discloses all claimed limitations (office action mailed 10/24/2006 pages 2-12), except providing a product sample, and that O'Brien discloses that limitation (office action mailed 10/24/2006 pages 12, first paragraph).

#### **A. What Deaton Discloses**

Deaton is directed to "Method and system for selective incentive point-of-sale marketing in response to customer shopping history". Title. It is generally directed towards using a point of sale system for issuing incentive coupons to customers in dependence upon a signal based upon previously entered customer identification codes and transactions data. Abstract.

Deaton discloses "improv[ing] a store's marketing and other customer relations programs by collecting transactional data for that store, both current and historical, that can be used to identify new or infrequent customers, develop customer profiles and to perform targeted marketing." Column 4 lines 57-61. Moreover, "targeted marketing will also be provided by the system based upon the types of products bought by the purchaser or the departments in the store from which the products were bought." Column 101 lines 43-45.

Deaton discloses that local processing of retail store data for providing coupons in that retail store. "The system develops and maintains a local customer database, allowing the store to accumulate customer information relevant to the store's customers over and above that information necessary for credit verification." Column 6 lines 57-60. "The system operates at an individual store, and maintains at that store a local customer database of customer records, each identified by the corresponding customer identification number." Column 5 lines 3-6. "In the case of a multiple store business, each store has a local transaction processing system, with one of the systems being designated a host site and the rest being designated remote sites." Column 6 lines 24-27.

Deaton discloses presenting the consumer with coupons for free products. "Thus, at the point-of-sale, coupons or other incentives may be generated which are specifically targeted to a specific customer based upon his prior history. Alternatively, coupons may be later mailed to the selected customer." Column 7 lines 33-37.

**B. What Deaton Fails to Disclose or Suggest that is Defined in Independent Claims 1, 23, 45, and 46**

**1. Implementing a Product Sampling Program, and Providing a product Sample - Claims 1, 23, 45, and 46**

As the examiner admits, Deaton does not disclose providing a product sample. The subject application discloses providing to a consumer a product sample. For example, the subject application discloses mailing product samples to the consumer's postal address or providing the product sample to the consumer at the point of sale.

Providing a consumer a free sample is not the same thing as providing a consumer a coupon for a free product. Deaton's coupon requires the consumer to act to redeem the coupon to get a product at reduces or no cost. Providing a product sample to a consumer requires no action on the part of the consumer. Thus, Deaton's coupons are conceptually different from the claimed product samples.

In contrast to Deaton, claims 1, 23, 45, and 46 define "A computer network implemented system [or method or program product] for implementing *product sampling* programs..." and the system or method designed to "communicate *instructions how to deliver sample products* to ... consumers." Deaton does not disclose or suggest those limitations.

The examiner cites Deaton column 75 lines 9-21 and column 102 lines 15-20 (at office action paragraph spanning pages 2 and 3 and first full paragraph on page 3) , for disclosing a system feature generating a *coupon* for a free turkey or soda. The page 102 lines 15-20 "offer" is in another example of Deaton providing coupons; it is not an example of providing product samples.

The examiner admits that Deaton "does not explicitly disclose mailing samples to the users or providing samples to the user at the point of sale." Office action mailed October 24, 2006, page 11 lines 12-13. In fact, Deaton does not even impliedly disclose the limitations in the independent claims related to mailing product samples to the users or providing samples to the user at the point of sale. As previously noted, Deaton's coupons are conceptually different from this application's free product samples. In that regard, Deaton does not specify the claimed limitations of "communicate *instructions how to deliver sample products to postal addresses of consumers* associated with said first retailer selected CIDs and said second retailer selected CIDs..." of independent claims 1, 23, and 45. Similarly, Deaton's couponing does not disclose the concept of, upon identifying the consumer at the POS, delivering the free product to the consumer at that time. Thus, Deaton does not meet independent claim 46's limitation "communicate *instructions to a point of sale to deliver a sample product to a consumer at the point of sale during a transaction in which said point of sale detects the presence at the point of sale of one of said first retailer selected CIDs and said second retailer selected CIDs.*"

## **2. Deaton and O'Brien; O'Brien Does Not Disclose Product Sampling In Store Delivery - Claim 46**

The examiner now cites (new to this office action) O'Brien for disclosing "mailing samples to the users or providing samples to the user at the point of sale (Col 13, lines 35-51)." Office action mailed October 24, 2006 page 11 lines 14-15. The examiner then reasons that it would have been

obvious to modify Deaton by mailing sample products as taught in O'Brien, reasoning at page 11 lines 16-20 that:

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add O'Brien's mailing samples to the users or providing samples to the users at the point of sale to Deaton's mailing promotions to users and providing promotions at the point of sale and Deaton's providing free promotional sample items. One would have been motivated to do this in order to better promote purchasing.

In reply, the applicant first notes that O'Brien *does not disclose distributing product samples at the point of sale*. The examiner admits that Deaton does not disclose providing product samples at the point of sale. Since this is what claim 46 defines, there is no factual basis to maintain the obviousness rejection of claim 46.

**3. Deaton and O'Brien do not Suggest Postal Mailing Product Samples -  
Claims 1, 23, and 45**

The examiner cites O'Brien for "disclosing mailing samples to the users ...(col 13, lines 35-51)." Office action mailed October 24, 2006 page 11 lines 14-15. The examiner then reasons that it would have been obvious to modify Deaton by mailing sample products as taught in O'Brien, reasoning at page 11 lines 16-20 that:

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add O'Brien's mailing samples to the users or providing samples to the users at the point of sale to Deaton's mailing promotions to users and providing promotions at the point of sale and Deaton's providing free promotional sample items. One would have been motivated to do this in order to better promote purchasing.

The applicant agrees that O'Brien discloses postal mailing product samples. However, as to independent claims 1, 23, and 45, there is no rational basis for modifying Deaton in view of O'Brien to include postal mailing product samples based upon targeted marketing using purchase history data. This is because Deaton only discloses the concept of using coupons.

Modifying Deaton to provide for postal delivery of what Deaton discloses it provides (coupons) to consumers would mean postal mailing coupons to the consumers, which is not subject matter defined by any pending claim.

Modifying Deaton to postal mail products to consumers would defeat the purpose of Deaton, which is coupon generation; and providing consumers coupons at the point of sale. Recall for example Deaton's title indicates Deaton's contribution is "point of sale" marketing of "selective incentive[s]", and that is the concept, marketing by providing incentives at the point of sale, that Deaton discloses. Accordingly, as to claims 1, 23, and 45, there is no motivation to modify Deaton in view of O'Brien.

4. **Deaton and O'Brien do not Suggest a Central Computer System Determining CIDs to Assign to Product Samples - Claims 1, 23, 45, and 46**

Moreover, independent claims 1, 23, 45, and 46 define "wherein said central computer system is programmed to: [determine CIDs from different retail stores to which to assign product samples ] ..."

Deaton does not disclose using a central computer system/local computer system architecture and *using the central computer system to determine CIDs that meet criteria* for receipt of product samples at the multiple retail store local computers. All that Deaton discloses is local retail store computers systems; each computer system only determining CIDs for consumers of that store to provide coupons at that store's points of sale. The examiner apparently disagreed with this contention. See the 10/24/2006 office action page 16 lines 20-24, citing Deaton Fig. 19; Fig. 25; column 58 lines 25-36; column 76 lines 55-68; and column 83 lines 10-25.

In reply, the applicant submits that the examiner is incorrect. The passages of Deaton cited by the examiner do not support the examiner's contrary conclusion.

None of those Deaton passages disclose a central computer/local computer architecture and *using the central computer system to determine CIDs that meet criteria* for receipt of product samples for transactions at a retail store local computer. *Deaton only discloses each retail store's computer determining CIDs for consumers that should receive coupons in that retail store at that retail store's points of sale.* The applicant herein below reviews in detail each of the Deaton passages cited by the examiner, explaining why the examiner's conclusion is incorrect.

a. **Deaton Fig. 19 Disclosure, Cited by the Examiner**

The brief description of Fig. 19 states that "FIG. 19 is a block diagram of a second embodiment of the invention which provides check, credit card, debit card or the like transaction processing as well as targeted marketing." The body of Deaton describes Fig. 19 as the structure of the local retail stores' computer system, unrelated to any external central computer system. It states that:

FIG. 19 illustrates a block diagram of a typical embodiment of such a system in a retail store. At each POS exit from the store, there is provided a conventional Electronic Cash Register system ("ECR") 962A-E, which comprises an electronic cash register, a receipt printer and a UPC bar code scanner as will be subsequently described in greater detail in FIG. 20. In the same location at each POS exit at a retail store, there is found the AP/M and its associated peripherals which are designated generally by the numerals 963A-E.

The outputs of each of the ECRs 962A-E are applied through wires or other transmission link to a conventional ECR controller, which operates to provide conventional automatic cash register functions as are well known. Examples of such ECRs and ECR controllers are those manufactured and sold by IBM Corporation under the Model No. 4680ECR. Other conventional ECRs are manufactured and sold by NCR and other companies. The ECR controller is linked to the CVC master controller 965 by an integration link so that transaction data is input to the controller 965. It should also be noted that the present invention could be implemented solely within an ECR based system with suitable peripherals.

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Also referring to FIG. 19, the system illustrated is a system for one store. It will be appreciated that similar systems for multiple stores may be networked together such that information may be transferred between each store to provide marketing at different stores in different areas. Thus, the CVC controller 965 is connected via a dial-out telephone linked to other remote master controllers at other stores, which are in turn connected to various ECRs and AP/Ms at that store. In this way, not only can credit verification be accomplished between stores, but integrated credit and marketing techniques can be used to service individual customers at different stores and maintain a comprehensive listing of a customer's shopping history at multiple stores.

Pertaining to signals generated and sent to the point of sale relating back to Fig. 19, Deaton states that:

Data relating to the customer's unique identification code is applied from the individual AP/M 963A-E to the CVC controller 965, where it is associated with a database storage of the particular customer's past shopping history. The identification code is also used to provide credit verification. For checks, the verification procedure previously described in this application may be provided. In the case of credit cards, or the like, the credit card number may be checked against a periodically refreshed database in the controller 965, or the credit card number may be checked against a remote database in the known manner.

In dependence upon the credit check and the shopping history, as previously defined in this application and as will be subsequently described in greater detail with respect to this embodiment, the CVC controller 965 generates signals which are applied through the AP/M terminal to provide credit verification on the AP/M display and also to cause a high-speed printer at each point-of-sale location to print out a series of inducement coupons particularly designed to target that particular customer based upon the customer's prior shopping history. Alternatively, as will be subsequently described, electronic inducements may also be provided in lieu of the printed coupons, such as by the way of automatic discount of the customer's bill or by automatic discount of a future bill.

As will be described in greater detail, the present system thus enables a store to provide credit verification as well as to maintain accurate information regarding the shopping habits of its individual customers and to target marketing to those customers based upon the customer's individual shopping history. The present technique thus allows the targeting and incentive marketing of infrequent shoppers, as previously described and as will be described in subsequent detail.

The foregoing description of the Fig. 19 embodiment in Deaton contains nothing suggesting a central computer performing the CID determinations for multiple retail stores, as is claimed in this application.

**b. Deaton Fig. 25 Disclosure, Cited by the Examiner**

The brief description of the figures states that "FIG. 25 is a program flow diagram illustrating the storage and access of account records by the present system."

Deaton's detailed description states with respect to Fig. 25 that:

FIG. 25 illustrates the storage and access of account records for a network of the marketing systems and illustrates accessing the customer's account in the primary database of the CVC controller 965, as well accessing of data in the secondary database. The first database includes the customer's actual visits to the particular store. The secondary database comprises visits by the customer to the other stores interconnected with the system as shown in FIG. 19. As previously described in FIG. 19, each store may be connected via a dial-out telephone line with other remotely located CVC master controllers at other stores. The flow chart of FIG. 25 illustrates how data may be shared between the stores in order to both verify payments by customers, but also to provide target marketing of customers in a group of stores.

Of course, Deaton discloses that the CVC controller 965 is a device present in each local store. See the description of Fig. 19. Moreover, the statement that "each store may be connected via a dial-out telephone line with other remotely located CVC master controllers at other stores." indicates that each store maintains its own database, for whatever target marketing that store implements.

Thus, neither Fig. 25, Fig. 26, nor the descriptions thereof in Deaton suggest a central computer system that performs CID selection for multiple retail stores, as defined by claims 1, 23, and 45.

**c. Deaton Column 58 lines 25-36, Cited by the Examiner**

Deaton's column 58 lines 25-36 disclosure contradicts the examiner's conclusion that Deaton discloses a central computer system processing transaction data and sending the results to the retail store systems. It describes each one of Deaton's retail store systems as *autonomous systems*, stating that:

For example, in the case of multiple-store systems, the preferred embodiment includes separate, essentially autonomous check transaction processing systems at each store site, thereby permitting each store to establish and maintain an essentially local customer database, and limiting off-site data communications activities to remote/host file transfers for global update. However, the local customer database (and associated disk system) need not be located at the store site, but may be remote from the stores' transaction terminal network (such as by locating it in a central office) so long as: (a)



transaction terminal response time is not adversely affected and, (b) the essentially local character of the customer database for each is maintained.

The preferred embodiment's implementation of a multitasking system using a System Kernel for task-switching and intertask communications, can be readily adapted to operate under a commercial, multi-tasking operating system. These operating systems provide the task switching and intertask message communications functions performed by the System Kernel. Adapting the CTPS multi-tasking program to a commercially available multi-tasking operating system is well within the programming capabilities of those skilled in the art. Each program task would be modified in a conventional manner to accommodate the specific message communication function implemented by the multi-tasking operating system.

**d. Deaton Column 76 lines 55-68, Cited by the Examiner**

This passage also contradicts the examiner's conclusion that Deaton discloses the concept of a central computer performing analysis of multiple retail store data. It states that:

Also referring to FIG. 19, the system illustrated is a system for one store. It will be appreciated that similar systems for multiple stores may be networked together such that information may be transferred between each store to provide marketing at different stores in different areas. Thus, the CVC controller 965 is connected via a dial-out telephone linked to other remote master controllers at other stores, which are in turn connected to various ECRs and AP/Ms at that store. In this way, not only can credit verification be accomplished between stores, but integrated credit and marketing techniques can be used to service individual customers at different stores and maintain a comprehensive listing of a customer's shopping history at multiple stores.

The passage "information may be transferred between each store to provide marketing at different stores in different areas. ... Thus, the CVC controller 965 is connected via a dial-out telephone linked to other remote master controllers at other stores." suggests that each store in fact performs its own marketing analysis, which is contrary to the examiners' conclusion.

**e. Deaton's Column 83 lines 10-25, Cited by the Examiner**

This passage also contradicts the examiner's conclusion that Deaton discloses the concept of a central computer performing analysis of multiple retail store data. It states that:

FIG. 25 illustrates the storage and access of account records for a network of the marketing systems and illustrates accessing the customer's account in the primary database of the CVC controller 965, as well accessing of data in the secondary database. The first database includes the customer's actual visits to the particular store. The secondary database comprises visits by the customer to the other stores interconnected with the system as shown in FIG. 19. As previously described in FIG. 19, each store may be connected via a dial-out telephone line with other remotely located CVC master controllers at other stores. The flow chart of FIG. 25 illustrates how data may be shared between the stores in order to both verify payments by customers, but also to provide target marketing of customers in a group of stores. The steps include:

Deaton's statement "The secondary database comprises visits by the customer to the other stores interconnected with the system as shown in FIG. 19." shows that each local store includes all data necessary for marketing to its customers, no matter where they shopped. This is of course contrary to the examiner's conclusion that Deaton discloses using a central computer for performing marketing functions for transaction data from plural retail store computers. Moreover the steps associated with Fig. 25 just after the quoted passage of column 83 lines 10-25 also show that it is the local computer system that performs the marketing analysis. Specifically, the sequence of steps described in the text following the foregoing quote explain that the local computer system merges data obtained for its customer's shopping at other stores with its own store data, clearly as the basis for determining what marketing signals to generate when that customer returns to that store.

In view of all of the foregoing, there is no basis in Deaton for the examiner's conclusion that Deaton discloses the claimed Central computer/ retail store computers hierarchy in which the central computer system determines CIDs to offer sample products, and transmits those CIDs to the corresponding retail store computer systems. In contrast to Deaton, claim 1 (and analog limitations in claims 25 and 43) define this hierarchy, in the following recitations:

1. (Previously Presented) A computer network implemented system for implementing product sampling programs, comprising: a central computer system; ... wherein said central computer system is programmed to:

determine, based at least in part on manufacturer promotional sample product criteria data, first offer data constituting a first offer for a first retailer to participate in a sampling program;

determine, based at least in part on manufacturer promotional sample product criteria data, second offer data constituting a second offer for a second retailer to participate in a sampling program;

transmit said first offer data to a first retailer computer system of said plurality of retailer computer systems;

transmit said second offer data to a second retailer computer system of said plurality of retailer computer systems;

receive from said first retailer computer system first retailer consumer profile data comprising CIDs of customers of said first retailer;

receive from said second retailer computer system second retailer consumer profile data comprising CIDs of customers of said second retailer;

determine from said first retailer consumer profile data, first retailer selected CIDs;

determine from said second retailer consumer profile data, second retailer selected CIDs;

wherein said first retailer selected CIDs are CIDs having data associated with them that satisfy consumer profile criteria data, wherein said consumer profile criteria are based at least in part upon said manufacturer promotional sample product criteria data;

wherein said second retailer selected CIDs are CIDs having data associated with them that satisfy consumer profile criteria, wherein said consumer profile criteria are based at least in part upon said manufacturer promotional sample product criteria data;

communicate instructions how to deliver sample products to postal addresses of consumers associated with said first retailer selected CIDs and said second retailer selected CIDs.

5. **Deaton and O'Brien do not Suggest the claimed function of "determine, based at least in part on manufacturer promotional sample product criteria**

***data, first offer data constituting a first offer for a first retailer to participate in a sampling program."* - Independent Claims 1, 23, 45, and 46**

Independent claims 1, 23, 45, and 46 define the central computer system is programmed to "determine, based at least in part on manufacturer promotional sample product criteria data, *first offer data constituting a first offer for a first retailer to participate in a sampling program.*" This limitation is supported and interpretable from the following disclosure in the specification:

[0165] In step 503, the central computer system 4 communicates sample product offer criteria data from step 502 via the WAN 10 to retailer computer systems 8a, . . . , 8n. This data defines an offer to retailers to participate in the promotional sample product offer.

[0166] In step 504, the central computer system 4 receives from one of the retailer computer systems 8a, . . . , 8n a response indicating whether the retailer accepts or rejects an offer to participate in the sample product offer program to the central computer system 4. A rejection response may include retailer defined conditional data, such as alternative sample product offer timing criteria data, that the manufacturer must agree to for the retailer to participate in the promotional sample program. A retailer's rejection response containing such conditional data defines a counter offer. The response is either an acceptance, rejection, or a conditional data counter offer. An acceptance constitutes a contract. The indication of acceptance may be transmission to the central computer system 6 of consumer profile data.

[0167] In step 505, the central computer system 4 determines whether the retailer accepted the offer.

[0168] In step 506, the central computer system 4 determines whether retailer conditional data from a retailer computer contains conditions within limits provided by the manufacturer, as may be specified in the manufacturer promotional sample product criteria data. If within limits, it is acceptable, and the central computer system 4 transmits an acceptance signal to the particular retailer's computer system that sent the conditional data. This acceptance constitutes a binding contract. Hence, the central computer system 4 enables the entity operating it to enter into contracts with retailers based upon the retailers individual conditions by automatically responding to retailer

conditional data. Alternatively, the users of the central computer system could respond to conditional data based upon their review of that data.

Nothing in Deaton corresponds to a central computer offering to a retailer to implement a product sample marketing program, and nothing in Deaton discloses or suggests the central computer determining that offer from criteria data provided to it by a manufacturer of the product to be sampled, as claimed. In addition, since Deaton contains no recognition of multiple retailer marketing, it also does not disclose or suggest the "second offer data constituting a second offer for a second retailer..." limitation defined by all of the independent claims. The examiner apparently disagrees, apparently citing Deaton column 104 lines 15-30, 55-68, column 4 lines 51-61, and column 83 lines 10-25. Office action page 10 last three lines. I say 'apparently', because the examiner has not corresponded each recitation of each claim to passages in Deaton. Therefore, it is not clear to what the examiner intends to refer. In any case: Deaton column 104 lines 15-30; and 55-68; column 4 lines 51-61; and column 83 lines 10-25; do not disclose the claimed limitation.

Deaton column 104 lines 15-30 indicates that Deaton's database stores a history of products purchased.

Deaton column 104 lines 55-68 indicates that Deaton's system can determine whether a customer is an infrequent shopper.

Deaton column 4 lines 51-61 indicates that Deaton's goals relate to activities within a store that facilitate transactions.

Finally, Deaton column 83 lines 10-25 indicates that each store has a database that stores transactions that occurred in that store and a database for that store's customers that occurred at some other store.

None of the Deaton passages cited by the examiner disclose or suggest a central computer system that functions to "determine, based at least in part on manufacturer promotional sample product criteria data, *first offer data constituting a first offer for a first retailer to participate in a sampling program.*" For this additional reason, the rejections of claims 1, 23, 45, and 46 are improper and should be withdrawn.

6. **Deaton and O'Brien do not Suggest the claimed function of "communicate instructions how to deliver sample products to postal addresses of consumers associated with said first retailer selected**

**CIDs and said second retailer selected CIDs." - Independent Claims  
1, 23, and 45**

Furthermore, claims 1, 23, and 45, as amended, recite "communicate instructions how to deliver sample products to postal addresses of consumers associated with said first retailer selected CIDs and said second retailer selected CIDs." Deaton does not disclose communicating instructions for delivery of sample products. Therefore, Deaton cannot suggest communicating instructions for delivery of product samples to postal addresses of consumers. For this additional reason, Deaton does not disclose or suggest claims 1, 23, and 45.

7. **Deaton and O'Brien do not Suggest the claimed function of "communicate instructions to a point of sale to deliver a sample product to a consumer at the point of sale during a transaction in which said point of sale detects the presence at the point of sale of one of said first retailer selected CIDs and said second retailer selected CIDs." - Claim 46**

Furthermore, new claim 46 recites "communicate instructions to a point of sale to deliver a sample product to a consumer at the point of sale during a transaction in which said point of sale detects the presence at the point of sale of one of said first retailer selected CIDs and said second retailer selected CIDs." Deaton does not disclose communicating instructions to a point of sale for deliver of a sample product to a consumer at the point of sale during a transaction involving the consumer associated with the CID. Again, all Deaton discloses is delivering coupons. For this additional reason, Deaton does not disclose or suggest claim 46.

**C. Dependent Claims 2, 6, 24, and 28**

Claim 2 recites:

2. (Previously Presented) The system of claim 1 wherein said central computer system is further programmed to:
- receive from said first retailer computer system first retailer offer response data indicating whether a first retailer has accepted, rejected, or counter offered said first offer;

receive from said second retailer computer system second retailer offer response data indicating whether a second retailer has accepted, rejected, or counter offered said second offer.

Deaton does not disclose the manufacturer or retailer making counteroffers, as admitted by the examiner. ("Deaton does not explicitly disclose the manufacturer or retailer making counteroffers." Office action mailed July 5, 2006 page 11 lines 3-4; Office action mailed 10/24/2006 page 12 lines 3-11.). However, the examiner asserts that:

However, Deaton discloses the manufacturer and retailer interacting and communicating in providing targeted promotions to the user. Deaton further discloses the manufacturer providing promotions based on retailer data or vice versa. Also, Deaton discloses the manufacturer and retailer communicating on providing promotions individually or together or in collaboration (see above). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that negotiations/communications/offers/counteroffers can occur between the manufacturer and retailer. One would have been motivated to do this in order to provide a way for the manufacturer and retailer to better communicate in the providing of manufacturer and/or retailer targeted promotions to the user(s). [Office action mailed July 5, 2006 page 11 lines 3-13.]

In response, the applicant points out that the examiner is both applying sloppy reasoning and improper hindsight in these assertions. Nothing in Deaton discloses a "computer network implemented system ... wherein said central computer system is programmed to: ... transmit said first offer data to a first retailer computer system" much less receive counter offers therefrom. In further contrast, claim 2 recites "central computer system is further programmed to: receive from said first retailer computer ... [and] said second retailer computer system ... retailer offer response data indicating whether ... [the first and second retailers have each] accepted, rejected, or counter offered said ... offer." Nothing in Deaton discloses that marketing decisions occur anywhere but in the retail store's own computer system; the computer system at that store. Since Deaton does not define a central computer receiving acceptances or rejections from retailer computers, Deaton cannot disclose or suggest these limitations, defined by dependent claims 2, 6, 24, and 28. O'Brien is also silent with respect to this concept.

**D. Dependent Claims 3 and 25**

Claim 3 recites:

3. (Previously Presented) The system of claim 1 wherein said central computer system is further programmed to:

receive from a first one of said retailer computer systems first retailer consumer profile data in a first data exchange data transmission format and interpret that data based upon predetermined specification of said first one of said retailer computer systems' first data exchange data transmission format; and

receive from a second one of said retailer computer systems second retailer consumer profile data in a second data exchange data transmission format and interpret that data based upon predetermined specification of said second one of said retailer computer systems' second data exchange data transmission format.

Nothing in Deaton discloses a central computer/local retailer POS computer architecture, for the reasons explained in detail above. Lacking different retailer data systems in different retailer store computers, and lacking a central computer to which all of that information is to be sent, Deaton provides no teaching suggesting a need for receiving transaction data at a central computer system in different formats. Therefore, Deaton provides no suggestion for a central computer system programmed to receive retailer consumer profile data in different data exchange data transmission formats, as claimed in claims 3 and 25. O'Brien is also silent with respect to this concept.

**E. Dependent claims 4 and 26**

Claim 4 recites:

4. (Previously Presented) The system of claim 1 wherein said central computer system is further programmed to:

determine based upon said manufacturer promotional sample product criteria data and retailer identification data, offer data constituting *different criteria to different retailers*.

Nothing in Deaton suggests anything other than a single retailer owning multiple retail stores, each of which has its own local POS computer system. Thus, nothing in Deaton would suggest applying different criteria to CIDs from different retail stores in order to determine CIDs to associate with a product sample. O'Brien is also silent with respect to this concept.

**F. Claims 5 and 27**



Claim 5 recites:

5. (Previously Presented) The system of claim 1 wherein said central computer system is further programmed to:

determine based upon said manufacturer promotional sample product criteria data and fulfillment house availability data, offer data constituting said first offer.

Deaton does not disclose product samples, and it does not disclose depending the whether to offer a coupon on fulfillment house availability data. A fulfillment house is one that fulfills, and in the claimed invention means the organization that sends the product samples to the consumer addresses associated with selected CIDs. Nothing in Deaton suggests anything related to fulfillment house or fulfillment house availability data, such as quantity of product samples in stock. Therefore, nothing in Deaton suggests a central computer system using fulfillment house availability data in part to determine what if any product sampling program to offer to a retailer. O'Brien is also silent with respect to this concept.

**G. Claims 6 and 28**

Claim 6 recites:

6. (Previously Presented) The system of claim 1 wherein said central computer system is further programmed to:

if said first offer has been counter offered, determine whether to accept said counter offer based upon said manufacturer promotional sample product criteria data, and, if said determination is to accept said counter offer, then to communicate that acceptance to said first one of said retailer computer systems.

Nothing in Deaton or O'Brien relates to the concept of a central computer system receiving counter offers from retailers and determining whether to accept or reject those counter offers, as defined in claims 6 and 28, much less in the context of a product sampling program.

**H. Claims 7-11 and 29-33**

Claim 7 recites:

7. (Previously Presented) The system of claim 1 wherein said central computer system is further programmed to:

transmit to said first retailer computer system consumer profile criteria data containing first retailer consumer profile criteria and a prompt to said first retailer

computer system to transmit to the central computer system consumer profile data meeting said first retailer consumer profile criteria.

Nothing in Deaton or O'Brien suggests a central computer system. Deaton discloses only that a first retail store local computer system (associated with the first retail store) can receive from other local computer systems associated with other retail stores owned by the same retailer, data for transactions associated with CIDs registered at the first retailer store local computer system. Nothing in Deaton's system corresponds to the local computer system performing data analysis to determine which CIDS meet certain profiles, and then sending the data records for those CIDs to a central computer system, as claimed by claims 7 and 29. O'Brien is also silent with respect to this concept.

Moreover, nothing in Deaton or O'Brien suggests the two part analysis defined by claims 8 and 29 wherein the local store performs some analysis determining CIDs that meet "first retailer consumer profile criteria" and then the central computer performs analysis to determine from that set of CIDs, those that meet "additional consumer profile criteria" in determining to whom to provide a product sample, as claimed in claims 8 and 30.

Furthermore, nothing in Deaton or O'Brien relates to retailer dependency of criteria, as claimed in claims 9 and 31.

Claims 9-11 depend from claim 8, and claim 8 depends from claim 7; similarly for claims 29-33.

#### **I. Claims 16-19 and 38-41**

Claims 16-19 recite:

16. (Previously Presented) The system of claim 1 further comprising a master database, said master database storing (1) manufacturer promotional sample product offer criteria and (2) consumer profile data.

17. (Previously Presented) The system of claim 16 wherein said manufacturer promotional sample product offer criteria contains one or more of (1) consumer profile criteria data, (2) sample product timing criteria data, (3) manufacturer post promotional product sales goals data, (4) post promotional product sales data, (5) pre promotional product sales data, (6) fulfillment criteria data, and (7) manufacturer contract terms criteria data.

18. (Previously Presented) The system of claim 16 wherein said consumer profile data contains (1) CIDs in association with one or more of (2) consumer address data, (3) consumer demographic data, and (4) consumer purchase history data.

19. (Previously Presented) The system of claim 18 wherein said consumer purchase history data contains at least one of date and values of each consumer purchase, identification of items purchased, dates on which items were each purchased, location of each purchase, time-of-day of each purchase, frequency of each purchase, recency of each purchase, and frequencies of purchases of different brands of competing goods.

Nothing in Deaton or O'Brien suggests a database storing: (1) manufacturer promotional sample product offer criteria and (2) consumer profile data (claim 16); or one or more of (1) consumer profile criteria data, (2) sample product timing criteria data, (3) manufacturer post promotional product sales goals data, (4) post promotional product sales data, (5) pre promotional product sales data, (6) fulfillment criteria data, and (7) manufacturer contract terms criteria data (claim 17).

Neither Deaton nor O'Brien discloses a central computer system, and lacking that element, there would be no basis for such a database, and no location where such a database could provide any utility.

#### **J. Dependent Claims 20 and 42**

Deaton does not disclose generating print files for printing delivery paperwork, as admitted by the examiner. ("Deaton does not explicitly disclose generating print files for printing delivery paperwork." Office action mailed July 5, 2006 page 11 line 14-15; office action mailed 10/24/2006 page 12 lines 11-12.) These claims define limitations related to counteroffers. Therefore, they are non obvious in view of Deaton. Since Deaton does not disclose providing a product sample, Deaton does not disclose delivering a product sample or printing delivery paperwork for product samples. These claims define limitations related to such delivery paperwork. Therefore, they are non obvious in view of Deaton.

The examiner argues that:

In regards to claim 20 and 42, Deaton does not explicitly disclose generating print files for printing delivery paperwork. However, Deaton discloses a printer (Fig . 21) and inventory records (col 103, lines 5-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Deaton

can print records or other information. One would have been motivated to do this in order to have a form of information presentation that is good for reviewing or analyzing. [Office action mailed July 5, 2006 page 11 lines 14-19; office action mailed 10/24/2006 page 12 lines 12-18.]

The examiner is correct that Deaton does not disclose printing files; Deaton only discloses printing coupons. Coupons are clearly not the claimed "delivery paperwork", and the examiner has not suggested that coupons correspond to delivery paper work. Deaton does not disclose printing *anything other than coupons* when delivering coupons to a consumer. Accordingly, Deaton provides no teaching suggesting printing when delivering anything to a consumer. Accordingly, there is no factual basis to support the examiner's conclusion.

Moreover, this application clearly defines delivery paperwork as not a coupon and as papers associated with delivering a product sample, stating (in the published version of the specification):

[0172] In step 603, the central computer system 4 *generates postal sorts and/or associated delivery paperwork*, dependent upon the fulfillment criteria. Alternatively, at step 603 or any one of steps 604 and 605, the central computer 4 may transmit consumer records containing information necessary to transmit samples to addresses associated with the CIDs to a computer (not shown) of a fulfillment house, in which case the fulfillment house's computer and equipment perform step 603 and the following steps.

\*\*\*

[0192] In step 10, a computer generates *postal sorts and/or associated delivery paperwork*. \*\*\*

[0194] In step 12, a computer system prints *delivery paperwork to one or more printers at product sample distribution center(s)*. \*\*\*

[0195] In step 13, automated machinery or personal at sample distribution center(s) *insert or affix printed delivery paperwork and samples to product sample packages*.

Accordingly, there is no basis for the examiner's legal conclusion and rejection of these claims.

**V. The Rejections of Claims 1-47 under 35 USC 103 based upon Deaton (5,687,322) in View of Rochon (20020046085)**

Rochon 20020046085 is disqualified as prior art under 35 USC 103(c). Therefore, these rejections are improper and should be withdrawn.

35 USC 103(c) states that:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

MPEP 706.02(l)(2) is titled "Establishing Common Ownership [R-2]" After its examples, it lays down the examination criteria for disqualification under 35 USC 103(c), stating in pertinent part, that:

The examiner must examine the application as to all grounds except 35 U.S.C. 102(e), (f) and (g) as they apply through 35 U.S.C. 103 only if the application file(s) establishes common ownership at the time the later invention was made. Thus, it is necessary to look to the time at which common ownership exists. If common ownership does not exist at the time the later invention was made, the earlier invention is not disqualified as potential prior art under 35 U.S.C. 102(e), (f) and (g) as they apply through 35 U.S.C. 103.

The facts below show that Rochon 20020046085 and this application were commonly owned when this, the later application, was filed.

Supermarkets Online, Inc. was originally a wholly owned subsidiary of Catalina Marketing Corporation.

On or about 4/12/1999 (See attachment 6, showing 4/12/1999 date), Catalina Marketing Corporation sold a minority in Supermarkets Online, Inc. to the Chicago Tribune.

Catalina Marketing Corporation has always been the 100% owner of Catalina Marketing International, Inc.

Attachment 8 is a copy of the cover page and page 28 of a FORM 10-K, and the cover page and pages 28 and 29 of another FORM 10-K filing for Catalina Marketing Corporation.

Not later than 1/4/2001, Catalina Marketing Corporation bought back the minority interest in Supermarkets Online, Inc. The paragraph spanning pages 28 and 29 shows that as of 1/4/2001,

Catalina Marketing Corporation had bought back from the Chicago Tribune all shares of in Supermarkets Online, Inc. Catalina Marketing Corporation thereafter was the 100 percent owner of Supermarkets Online, Inc. (until Supermarkets Online, Inc. was dis-incorporated sometime around 2004-2005).

Attachment 5 is a pdf image copy of the assignment records of the USPTO, for Rochon (application 09418509, which published as 20020046085). The records of the USPTO show that the Rochon (application 09418509, which published as 20020046085), was originally assigned on 9/24/1999 by the inventors to Supermarkets Online, Inc., filed on 10/15/1999, and reassigned on 7/30/2002 to Catalina Marketing International, Inc.

The records of the USPTO show that this application 09873185 was assigned on 8/23/2001 by the inventors to Catalina Marketing International, Inc., and filed 6/5/2001. Attachment 4 is a pdf image copy of the assignment records of the USPTO, for this application 09873185.

Therefore, the records of the USPTO show that this application and Rochon were commonly owned at the time this application was filed.

Attachment 1 is an invention disclosure form submitted by the inventors to their employer prior to 1/4/2001. It contains a section 8 entitled "Description of the Invention" stating the following:

Description of Invention:

Direct Mail delivery of new product sample to selected, targeted households based on actual purchase behaviors collected in several retailers frequent shopper databases. The samples were delivered to households with the retailer's logo and Club Card reference on the outside of the box with an informational insert provided. [Page 1 item 8 of Attachment 1.]

The invention disclosure discloses many of the limitations of the now claimed inventions. The invention disclosure was made in the context of a Catalina employee, wherein Catalina was in the business of obtaining at a central site computer system purchase history data associated with consumer CIDs from many retail stores, and using that data for marketing, primarily via coupons printed in those retail stores for specified consumers and purchases (targeted marketing based upon prior purchase history and current transaction content). In that context, many of claim 1's limitations are implied by what the invention disclosure states. These limitations are identified below, with reference to claim 1:

1. (Previously Presented) A computer network implemented system for implementing product sampling programs, comprising (implied from context because Catalina previously obtained "actual purchase behaviors" at its central site from a large number of retailer stores and analyzed that data at its central site):

a central computer system; (implied)

a communications medium over which the central computer system can communicate with each one of a plurality of retailer computer systems; (implied)

wherein said central computer system is programmed to:

... (missing)

...(missing)

...(missing)

...(missing)

receive from said first retailer computer system first retailer consumer profile data comprising CIDs of customers of said first retailer; (implied)

receive from said second retailer computer system second retailer consumer profile data comprising CIDs of customers of said second retailer; (implied)

determine from said first retailer consumer profile data, first retailer selected CIDs; (implied)

determine from said second retailer consumer profile data, second retailer selected CIDs; (implied)

wherein said first retailer selected CIDs are CIDs having data associated with them that satisfy consumer profile criteria data, wherein said consumer profile criteria are based at least in part upon said manufacturer promotional sample product criteria data; (implied)

wherein said second retailer selected CIDs are CIDs having data associated with them that satisfy consumer profile criteria, wherein said consumer profile criteria are based at least in part upon said manufacturer promotional sample product criteria data; (implied)

communicate instructions how to deliver sample products to postal addresses of consumers associated with said first retailer selected CIDs and said second retailer selected CIDs. (implied)

The limitations of claim 1 not disclosed, and identified above as "(missing)" from the foregoing invention disclosure are:

determine, based at least in part on manufacturer promotional sample product criteria data, first offer data constituting a first offer for a first retailer to participate in a sampling program;

determine, based at least in part on manufacturer promotional sample product criteria data, second offer data constituting a second offer for a second retailer to participate in a sampling program;

transmit said first offer data to a first retailer computer system of said plurality of retailer computer systems;

transmit said second offer data to a second retailer computer system of said plurality of retailer computer systems;

Essentially the same limitations exist in the other independent claims, claims 23, 45, and 46. Since the invention disclosure lacks these limitations present in the independent claims, the claimed invention was not made as of the date of the invention disclosure. The undersigned, although having made reasonable inquiries, has no additional evidence relevant to priority of invention for the claims of this application. See attachment 9, which is an email evidencing the inquiries. Accordingly, the earliest evidence of date of invention of what is claimed is the date of assignment; 8/23/2001. On that date, 8/23/2001, Rochon and this application were commonly owned. Therefore, Rochon is disqualified as prior art under 35 USC 103(c). Therefore, these 103 rejections are improper and should be reversed.

#### **VI. The Rejections of Claims 1-47 under 35 USC 103 based upon Deaton (5,687,322) in View of Rochon (WO00/68849)**

The office action rejects claims 1-47 under 35 USC 103 as obvious based upon a combination of Deaton 5687322 and Rochon WO00/68849. However, Rochon WO00/68849 is not prior art; it is antedated by the evidence submitted herewith. With respect to removing a reference timewise, "all the



applicant[s] can be required to show [to remove the reference] is priority with respect to so much of the claimed invention as the reference happens to show." In re Stempel, 241 F.2d 755, 759, 113 USPQ 77, 81 (CCPA 1957). In this case, the invention disclosure shows that the inventors had possession of all relevant limitations in Rochon WO00/68849; the limitations in Rochon WO00/68849 relied upon by the examiner. Moreover, Rochon WO00/68849 was published 11/16/2000, whereas the invention disclosure is dated 8/2000 (Attachment 1), and it is attached to an email dated 9/2000 (Attachment 2). Therefore, based upon the showing below of what the invention disclosure discloses, Rochon Rochon WO00/68849 is antedated.

As noted above, the invention disclosure (Attachment 1) discloses all limitations of claims 1, 23, 45, except for the following.

determine, based at least in part on manufacturer promotional sample product criteria data, first offer data constituting a first offer for a first retailer to participate in a sampling program;

determine, based at least in part on manufacturer promotional sample product criteria data, second offer data constituting a second offer for a second retailer to participate in a sampling program;

transmit said first offer data to a first retailer computer system of said plurality of retailer computer systems;

transmit said second offer data to a second retailer computer system of said plurality of retailer computer systems;

That is, independent claims 1, 23, 45, and 46 define the central computer system is programmed to "determine, based at least in part on manufacturer promotional sample product criteria data, *first offer data constituting a first offer for a first retailer to participate in a sampling program.*" This limitation is supported and interpretable from the following disclosure in the specification:

[0165] In step 503, the central computer system 4 communicates sample product offer criteria data from step 502 via the WAN 10 to retailer computer systems 8a, . . . , 8n. This data defines an offer to retailers to participate in the promotional sample product offer.

[0166] In step 504, the central computer system 4 receives from one of the retailer computer systems 8a, . . . , 8n a response indicating whether the retailer accepts

or rejects an offer to participate in the sample product offer program to the central computer system 4. A rejection response may include retailer defined conditional data, such as alternative sample product offer timing criteria data, that the manufacturer must agree to for the retailer to participate in the promotional sample program. A retailer's rejection response containing such conditional data defines a counter offer. The response is either an acceptance, rejection, or a conditional data counter offer. An acceptance constitutes a contract. The indication of acceptance may be transmission to the central computer system 6 of consumer profile data.

[0167] In step 505, the central computer system 4 determines whether the retailer accepted the offer.

[0168] In step 506, the central computer system 4 determines whether retailer conditional data from a retailer computer contains conditions within limits provided by the manufacturer, as may be specified in the manufacturer promotional sample product criteria data. If within limits, it is acceptable, and the central computer system 4 transmits an acceptance signal to the particular retailer's computer system that sent the conditional data. This acceptance constitutes a binding contract. Hence, the central computer system 4 enables the entity operating it to enter into contracts with retailers based upon the retailers individual conditions by automatically responding to retailer conditional data. Alternatively, the users of the central computer system could respond to conditional data based upon their review of that data.

Nothing in Rochon WO00/68849 corresponds to a central computer determining offer data specific to different retailers to participate in a product sampling program, as defined above. What Rochon discloses is instead in step 12 sending manufacturer offers via email to email addresses of users (customers), not retailers. See Rochon WO00/68849 page 8.

Thus, the invention disclosure discloses all limitations of the claimed invention arguably disclosed by Rochon WO00/68849. Therefore, it meets the requirements for antedating specified in Stempel that, with respect to removing a reference timewise, "all the applicant[s] can be required to show [to remove the reference] is priority with respect to so much of the claimed invention as the reference happens to show." In re Stempel, 241 F.2d 755, 759, 113 USPQ 77, 81 (CCPA 1957). Accordingly, Rochon WO00/68849 is not prior art.

Turn now to what the examiner states. The examiner cites Rochon for the following:

However, Rochon discloses mailing samples to the users or providing samples to the user at the point of sale (Abstract; page 6-7, "in step 6"; page 9, "step 18"; claim 11).

[Office action mailed 11/24/2006 page 14 lines 19-20.]

In reply, the applicant submits that nothing cited by the examiner discloses providing samples to the user at the point of sale. Rochon WO00/68849's abstract refers only to an address for a user. Rochon WO00/68849's pages 6 and 7 do not relate to delivery of sample products. Rochon WO00/68849's pages 6-7 "in step 6" paragraph discloses only data capture at a point of sale. Rochon WO00/68849's page 9 "step 18" paragraph disclose only product sample delivery to users via postal or delivery service. Nothing cited by the examiner discloses providing samples to the user at the point of sale. Thus, nothing cited by the examiner discloses providing product samples to the user at the point of sale, as defined by claim 46.

Moreover, the examiner has not asserted that Rochon WO00/68849 contains anything else relevant to any claim, and Rochon WO00/68849 does not disclose many of the limitations discussed above in relation to the rejections of the dependent claims based upon Deaton and O'Brien.

**VII. The Rejections of Claims 1-47 Alternatively under 35 USC 102(e) as Anticipated or Under 35 USC 103 as Obvious Based Upon Rochon (20020046085)**

The rejections of Claims 1-47 as obvious in view of Rochon 20020046085 are improper because, as the applicant has shown above, Rochon 20020046085 is disqualified under 35 USC 103(c) from prior art.

First, we address the alternative rejection under 35 USC 102(e).

Rochon 20020046085 has the same disclosure as Rochon WO00/68849. Rochon 20020046085 also therefore fails to disclose the following features of the independent claims.

For claims 1, 23, 45, and 46:

determine, based at least in part on manufacturer promotional sample product criteria data, first offer data constituting a first offer for a first retailer to participate in a sampling program;

determine, based at least in part on manufacturer promotional sample product criteria data, second offer data constituting a second offer for a second retailer to participate in a sampling program;

transmit said first offer data to a first retailer computer system of said plurality of retailer computer systems;

transmit said second offer data to a second retailer computer system of said plurality of retailer computer systems;

For claim 46:

communicate instructions to a point of sale to deliver a sample product to a consumer at the point of sale during a transaction in which said point of sale detects the presence at the point of sale of one of said first retailer selected CIDs and said second retailer selected CIDs.

Therefore, no independent claim, and therefore no claim, is anticipated by Rochon 20020046085.

The examiner apparently disagrees, asserting that:

7. Claims 1-47 rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rochon (WO 00168849).

Please see the 35 USC 102 and 35 USC 103 rejection utilizing Rochon (200210046085) above.

In reply, the applicant notes that the examiner did not assert in the rejection utilizing Rochon (200210046085) as a secondary reference in addition to Deaton as the primary reference, the limitations of any claim being disclosed by Rochon. All the examiner asserted was that "Rochon discloses mailing samples to the users or providing samples to the user at the point of sale." Thus, the examiner has not prima facie explained how Rochon (200210046085) anticipates any claim. And, as noted above, Rochon in fact does not disclose providing samples to the user at the point of sale. Therefore, these rejections should be withdrawn.

**VIII. Closure**

This application should now be allowed. Should the examiner have any questions, or if the examiner desires to allow the application and is authorized to do so, and has some minor points to discuss, the examiner is urged to contact the undersigned at 703-415-0012 ext. 21.

3/22/2007

DATE

Respectfully Submitted,

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Richard A. Neifeld

Registration No. 35, 299

Attorney of Record

RAN

Printed: March 22, 2007 (3:56pm)

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